

## **REMARKS**

It is respectfully requested that the amended claims be reconsidered and based on the following allowed.

### **New Matter Objection (35 U.S.C. §132(a)) and 35 U.S.C. §112 Rejection**

Claims 21-39 have been objected to under 35 U.S.C. §132(a) as introducing new matter by using the terms: "a single spin outcome" and "the single spin outcome." Claims 21-39 have been further rejected under 35 U.S.C. §112 (first paragraph) for not mentioning these terms in the specification.

The Examiner is correct, the word "single" is not used in the specification. However, through out the specification the following terminology is used: "the outcome" (page 3, lines 24-25 and line 27); "the outcome" (page 4, line 18); "the reels stop" (page 5, line 5); "a matrix of symbols" (page 5, line 11); "a reel-stop position" (page 7, line 15); "this spin result" (page 8, line 19 and line 20); "this spin" (page 9, line 9); "this outcome" (page 9, lines 12-13); "displaying a matrix of symbols" (originally filed claims). Figures 1-5 illustrate each of the above.

The undersigned, based on the Examiner's comment in the 1/7/05 Office Action, amended the claims to recite "single spin outcome." It is respectfully maintained that each of the above references and the figures fully support the use of the word "single" and that this does not constitute new matter. However, to comply with the objection, the use of the word "single" is removed. These amendments also overcome the 35 USC §112, first paragraph, rejection.

The preamble in each independent claim has been amended to recite: "A method for operating a casino slot machine to a reel stop position having a spin outcome displaying a matrix of symbols having a plurality of pay lines in response to a wager on all of the plurality of pay lines received from a player." Evidence of the skill in the art is found in the Bennett '758 reference at column 1, lines 29-45, column 3, lines 60-65, column 4, lines 8-14, Figure 3 and column 5, lines 43-46. None of this is new matter, all terminology used is found in the specification, and the preamble states what is conventional to a game outcome comprising a display of a matrix of symbols in the spin outcome of multi-reels, multi-pay lines of a casino slot machine in response to a wager received from a player.

With these amendments the 35 U.S.C. §132(a) objection and the 35 U.S.C. §112, first paragraph, rejection are believed to have been both overcome.

### **Drawing Objection (37 C.F.R. 1.83(a))**

New amended Figure 7 in compliance with 37 C.F.R. 1.121(d) is herein resubmitted. No new matter has been introduced. It is respectfully maintained that every feature is now shown.

For example, claim 21 has every feature shown in Figure 7. With respect to amended Figure 7, a new method step box 705 is provided such that when the at least one trigger symbol is provided, the player is alerted of the selectable wild feature. This is not new matter as it is fully presented on line 5 of paragraph [0038]. This paragraph has been amended to recite that this alert feature appears in Figure 7, step 705. As a result of adding step 705, step 706 has been amended appropriately. The other language added to the existing features are found throughout the specification. Hence, no new matter has been added.

With respect to claim 29, claim 29 further includes the feature of converting the trigger symbol to a wild symbol. This has been added in to Figure 7 in dotted lines as optional method step 709. This does not constitute new matter as it is fully discussed also in paragraph [0038]. With respect to independent claim 34, Figure 7, step 706 fully supports that the player can select any one of the displayed symbols including the trigger symbol which is found in paragraph [0040]. With respect to independent claim 35, the feature of a trigger symbol randomly appearing (and not limited to appearing in the display matrix) is fully supported in added step 705.

It is maintained that each independent claim has the features found therein fully supported in all of the drawings especially Figure 7, as amended.

### **Bennett 35 U.S.C. §102(e)**

Claims 21, 23, 27, 28, 34-36, 38 and 39 are rejected based on Bennett (6,648,758). It is respectfully maintained that the claims **as presently amended** are patentably distinct over the disclosure of Bennett.

As correctly pointed out by the Examiner, Bennett provides a spinning video reel base game that a player plays (column 3, lines 66-67). When a trigger combination of specific symbols appear in the outcome (Figure 3) of the video reel base game, a feature game (Figure 5) may then be played by the player (column 4, lines 2-4). The appearance of two wild symbols in the video reel game outcome of Figure 3 on the display screen substitutes for wins, pays twenty times the usual prize and triggers the feature game (column 5, lines 47-63). After this

occurs, the video reel base game outcome is gone and a new display (Figure 4) appears. **The player, in Bennett, is never permitted to touch and change any symbol in the video reel base game outcome (Figure 3) to improve his/her winning combinations as claimed by the pending claims.**

Claim 21 provides "the player with a touch input on any one of the remaining displayed symbols in the matrix of symbols of the aforesaid spin outcome, other than the trigger symbol" so as to enhance his/her winning combinations in the base reel game by selecting a wild symbol in the symbols displayed in the matrix of the casino slot machine. The player in the claimed invention does this "so as to obtain any winning combinations having higher corresponding awards based on the pay table than winning combinations found in the aforesaid spin outcome" (claim 21). Bennett has no such disclosure under §102 or teaching under §103. There is nothing the player can do in Bennett to touch and change the winning combinations in the video reel base game outcome of Figure 3!

Bennett further departs from the claimed invention, as amended, herein. The video reel base game and the feature game (Figure 5) are different games with the feature game being themed (column 4, lines 8-17). Bennett refers to the feature game as a "bonus game" (column 4, line 5). Not only is the feature bonus game a separate game, but as correctly stated by the Examiner the player is given three choices to select on an intermediate screen (Figure 4) that affect the feature game play (column 4, lines 18-21). Two significant requirements are found in '758 Bennett: (1) the bonus game is a separate feature game from the video reel base game and (2) the player has control (Figure 4) over the play of the feature game (Figure 5). Neither feature is found in the claimed inventions.

In summary, the appearance of wild symbols in Bennett triggers play of the feature game and the screen **automatically changes** (from Figure 3 to Figure 4) (column 5, lines 49-53). At this point, the player is given various options on how to play the feature game (none of which affect the video reel base game outcome). **The Bennett video reel base game outcome in Figure 3 is gone and never comes back.** The player selects an option in Figure 4 and then the first (of many) spin outcomes of the feature games are displayed using the player selected option such as is shown in Figure 5.

Everything that occurs in the claimed invention occurs in the displayed matrix of symbols for the spin outcome in the casino slot machine. Bennett does not disclose the claimed

invention nor would the claimed invention been obvious in view of the teachings of Bennett. As fully illustrated and discussed in the application, claim 21 recites that, in response to a wager on all of the plurality of pay lines a spin outcome randomly displays a matrix of symbols on a touch screen. When a trigger symbol is displayed in the spin outcome, the player is alerted that he/she is qualified to play a "wild selectable feature." The casino slot machine receives a touch input from the player "on any one of the remaining displayed symbols in the matrix of symbols of the aforesaid spin outcome, other than the trigger symbol." The touched symbol is converted to a wild symbol on the matrix of symbols of the spin outcome. The player is awarded for any winning symbol combinations based on a pay table in the matrix of symbols of the spin outcome of the casino slot machine. Claim 21 has been amended to recite that all player selection and game play occurs on the "aforesaid spin outcome" of the casino slot machine which refers back to the spin outcome as a result of the wager. Bennett does not disclose this under §102(e), nor is there any teachings in Bennett under §103.

To recap, Bennett does not disclose any of the following method steps in claim 21 providing for player interaction on the displayed game outcome:

"... the player selectable wild feature providing the player with a touch input on any one of the remaining displayed symbols in the matrix of symbols of the aforesaid spin outcome on the touch screen display, other than the trigger symbol, so as to obtain any winning symbol combinations having higher corresponding awards based on the pay table than winning combinations found in the aforesaid spin outcome;

receiving the touch input from the player on one symbol of the remaining displayed symbols in the matrix of symbols on the touch screen display for the aforesaid spin outcome in response to alerting the player;

converting the aforesaid one touched symbol to a wild symbol in the displayed matrix of symbols for the aforesaid spin outcome on the touch screen display in response to receiving the touch input;

awarding the player awards corresponding to any winning symbol combinations on the plurality of pay lines based on the pay table and in response to converting the one touched symbol to the wild symbol in the matrix of symbols of the aforesaid spin outcome." (emphasis added)

The emphasized language specifies that the player interacts with only the spin outcome received and displayed as a matrix of symbols in the touch screen in response to the wager. Claim 21 sets forth another feature NOT found in Bennett: the player touches symbols other than the trigger symbol. Bennett does not disclose any teaching wherein the player touches "any" symbol in Figure 3 to accomplish anything.

Claim 23 depends from claim 21 and further recites having an enhanced multiplier with the one touch symbol which refers back to the touched symbol of the spin outcome obtained in the response to the wager. There is no opportunity in Bennett for the player to touch any symbol in the original reel spin outcome let alone associating an enhanced multiplier therewith. The rejection refers claim 23 to Figure 5 of Bennett, but Figure 5 of Bennett is two distinct screens later so that there is no further play of the screen presentation of Figure 3 in Bennett by the player as occurs in the claimed invention in claim 23 when read with independent claim 21.

Claim 27 further details that the step of alerting presents instructions to the player on how to play the player selectable wild feature of the claimed invention. Claim 27 when read with parent claim 21 is patentably distinct for the reasons set forth above.

Dependent claim 28 further details that the step of alerting occurs in a multimedia presentation to the player on how to play the player selectable wild feature of the claimed invention. Claim 28 when read with parent claim 21 is patentably distinct for the reasons set forth above.

With respect to independent claim 34, the arguments set forth with respect to independent claim 21 are incorporated by reference and it is maintained respectfully for these reasons alone, claim 34 is patentable. The claim difference between claim 34 and claim 21 pertains to the distinction that the player can now (in claim 34) touch any one of the displayed symbols including the trigger symbol. In the Bennett reference, as pointed out above, the player can not touch any of the symbols including the two wild symbols in Figure 3 and have any further play with the video reel spin outcome of Figure 3. Such further play of Figure 3 does not exist whatsoever in Bennett.

Independent claim 35 is like independent claim 34, but in addition instructions are presented to the player and the trigger can be any trigger initiation.

Dependent claims 36 and 38 depend from independent claim 35 and recites that the trigger initiation is random (claim 36) and is a trigger symbol in a predetermined area of the display matrix of symbols (claim 38). These dependent features when read with independent claim 35 are patentably distinguishable over Bennett for the reasons discussed previously.

Dependent claim 39 when also read with independent claim 35, as a whole, is patentably distinct for the reasons set forth above over Bennett. It is recognized that touch screens are well known in casino gaming machines.

### **35 U.S.C. §103(a) Rejections**

For the reasons set forth above with respect to claim 21, when claim 24 is read with claim 21, claim 24 is patentable over Bennett.

Claims 22, 25, 26, and 29-33 are rejected under 35 U.S.C. §103(a) based on Bennett in view of O'Halloran. For the reasons set forth above with respect to Bennett, and with respect to claims 22, 25, and 26, these claims are allowable as independent claim 21 is patentably distinct over Bennett. With respect to claims 29-33, the same features found in independent claim 21 are found in independent claim 29 with the addition of automatically converting the trigger symbol to a wild symbol. Hence, it is maintained that claims 29-33 are patentably distinct over Bennett. O'Halloran does not provide any of the teachings with respect to the independent claim 29 as discussed with respect to independent claim 21 and hence all of these claims are patentably distinct. O'Halloran teaches that a wild symbol appears and then alters one or more other symbols to create additional winning opportunities.

Claim 37 is rejected based on Bennett in view of Stupak. Again, the arguments set forth with respect to independent claim 35 as set forth above are incorporated herein by reference. When dependent claim 37 is read into independent claim 35, it is patentably distinct over Bennett. Stupak provides no teachings with respect to independent claim 35 and hence claim 37 is patentably distinct over Bennett in view of Stupak. Stupak has no relevance to the teaches of the independent claim and only teachings paying an award for multiple successive losses with either player wagering on the sequence of losses or adjusting probability of a win based on a number of successive losses.

Neither Stupak or O'Halloran teaches, suggests, or infers that the player has any control whatsoever over a spin outcome as fully taught in each of the independent claims of the present invention.

It is maintained that all claims are in condition for allowance and such allowance is respectfully requested.

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

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Date: 9/20/05

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